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Reexam #18

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<b>TRANSMITTAL FORM</b> (To be used for all correspondence after initial filing)  <b>RECEIVED</b> AUG 18 1998 SPECIAL PROGRAMS OFFICE DAG FOR PATENTS	Reexam Control Number	90/004,752		
	Reissue Number	09/014,518		
	U.S. Patent No.	5,472,790	Reexam Date	9/17/97
			Reissue Date	1/28/98
	First Named Inventor	RODERICK THOMPSON		
	Group Art Unit	1615		
Examiner Name	W.A. Krynski			
Total Number of Pages in this Transmission	12	Attorney Docket Number	5355-RE02	

<b>ENCLOSURES (check all that apply)</b>		
<input type="checkbox"/> Fee Transmittal Form	<input type="checkbox"/> Assignment Papers (for an Application)	<input type="checkbox"/> After Allowance Communication to Group
<input type="checkbox"/> Fee Attached	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> Appeal Communications to Board of Appeals and Interferences
<input type="checkbox"/> Amendment/Response	<input type="checkbox"/> Licensing-related Papers	<input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief)
<input type="checkbox"/> After Final	<input type="checkbox"/> Petition Routing Slip and Accompanying Petition	<input type="checkbox"/> Proprietary Information
<input type="checkbox"/> Extension of Time Request	<input type="checkbox"/> To Convert a Provisional Application	<input type="checkbox"/> Status Letter
<input type="checkbox"/> Express Abandonment Request	<input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address	<input checked="" type="checkbox"/> Additional Enclosure(s) (please identify below)
<input type="checkbox"/> Information Disclosure Statement	<input type="checkbox"/> Terminal Disclaimer	Reply to Petition to Institute Public Under Proceeding Under 37 C.F.R. § 1.292 (in duplicate)
<input type="checkbox"/> Certified Copy of Priority Document(s)		Copy of Transmittal
<input type="checkbox"/> Response to Missing Parts/Incomplete Application		
<input type="checkbox"/> Response to Missing Parts Under 37 CFR 1.52 or 1.53	Remarks	
Please charge any additional fee required to Deposit Account No. 02-4070		

<b>SIGNATURE OF APPLICANT, ATTORNEY OR AGENT</b>			
ATTORNEY NAME	Lawrence D. Maxwell, Esq.		
FIRM	BROWN, MARTIN, HALLER & McCLAIN, LLP		
SIGNATURE			
DATE	August 10, 1998		
I hereby certify that this correspondence is being facsimile transmitted to the Assistant Commissioner for Patents at (703) 305-5436 on this date: August 10, 1998			
Typed or printed name	Lawrence D. Maxwell		
Signature		Date	August 10, 1998



REISSUE LITIGATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Reissue Application and Reexamination (merged proceeding) of	)	FOR: PREPARATION AND TRANSFER SHEET
Patentee: RODERICK THOMPSON	)	Patent No. 5,472,790
Reissue Serial No.: 09/014,518	)	Reexamination Control No. 90/004,752
Reissue Filed: January 28, 1998	)	Reexam Filed: September 17, 1997
	)	Group Art Unit: 1615

**REPLY TO PETITION TO INSTITUTE PUBLIC UNDER PROCEEDING  
UNDER 37 C.F.R. § 1.292**

BOX 7  
Assistant Commissioner for Patents  
Washington, D.C. 20231

Attention: W. Krynski  
Examiner

Dear Sir:

Patent Owner hereby replies to the petition to institute public use proceeding filed by Petitioner Progressive International Corporation, dated May 26, 1998, and the supplements Petitioner filed thereto, dated June 5, 1998 and July 21, 1998.

Patent Owner believes that a public use proceeding would be duplicative of the reissue/reexamination proceeding and would not produce any new evidence not already of record or able to be made of record in the reissue/reexamination proceeding through documentary and supporting testamentary evidence. The purpose of a public use

proceeding is to establish through testimony the truth of the facts asserted by a petitioner (see MPEP 720.02), but Petitioner's asserted facts are all supported by documentary evidence, the authenticity of which Patent Owner does not challenge. Moreover, none of the items submitted by Petitioner establishes a prima facie case of public use or sale of the claimed subject matter.

Petitioner based its original Petition dated May 26, 1998 on alleged sales or offers for sale in the United States by Mr. William Fishman of a cutting mat under the name "Counter Maid." Patent Owner submits that the Counter Maid mat is already of record in the reissue/reexamination, and Patent Owner does not dispute that the Counter Maid was sold or offered for sale to an extent that qualifies it as prior art. Patent Owner has already stated as much in the reissue application and reexamination documents. Petitioner also submitted documents evidencing the results of tests conducted by OCM Laboratories. These documents are admissible in the reissue/reexamination, and although the Examiner is entitled to question their accuracy, probative weight and other issues, Patent Owner presently has no reason to believe the test results do not relate to the Counter Maid mat. Thus, a public use proceeding would not add any evidence to that which is already now of record or can be made of record in the reissue/reexamination in the form of documentary evidence.

Similarly, in Petitioner's supplement dated June 5, 1998, Petitioner submitted a document (an invoice from Socopac Co.) evidencing that Patent Owner purchased a

quantity of polypropylene sheets 0.022 inches in thickness. Patent Owner submits that this document stands on its own as valid documentary evidence, and Patent Owner does not dispute that Patent Owner made the purchase evidenced by the invoice. Patent Owner does, however, question the relevance of this document, as it only evidences Patent Owner's purchase of the raw material (sheet plastic) for making the cutting mats, and does not evidence a sale of what is claimed. Furthermore, although as Petitioner pointed out, the claims directed to thicknesses over 0.030 inches are not entitled to the benefit of the filing date of the original parent application serial No. 07/994,665, the sheets that were purchased were 0.022 inches in thickness and thus not within the scope of those claims. Rather, the sheets were only within the scope of the claims directed to the lower thicknesses, and those claims are entitled to the benefit of the earlier filing date. The sale evidenced by this invoice is therefore not prior art and cannot raise a prima facie case of prior sale.

In Petitioner's second supplement dated July 21, 1998, Petitioner pointed to GB2248177A and to the Modern Plastics reference and test result data, all of which is documentary evidence already of record in the reissue/reexamination. Petitioner also submitted a declaration of Mr. David Phaller regarding the "lay flat" characteristics of the sheets from which the Counter Maid mat was apparently made. This evidence, too, can be submitted in the reissue/reexamination. Again, the Examiner is entitled to afford this


declaration whatever evidentiary weight he deems proper, but there is no additional useful evidence that could be revealed through the taking of testimony in a public use proceeding.

For the foregoing reasons, Patent Owner respectfully urges the Commissioner not to institute a public use proceeding because it would not result in the discovery of any useful evidence beyond that which is already of record or can be made of record in this reissue/reexamination. Moreover, none of the items that Petitioner has submitted establishes a prima facie case of public use or sale of the claimed subject matter.

This reply is filed in duplicate for entry in both the reissue and reexamination files.

Respectfully submitted,

Dated: August 10, 1998

By:   
Lawrence D. Maxwell  
Attorney for Patent Owner  
Registration No. 35,276

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Docket No.: 5355-RE02



Control No. 90 /004,752/Ser. No. 09/014,518

### PROOF OF SERVICE

I, MARY E. GILLETTE, declare that: I am over the age of eighteen (18) years and not party to the case. I am employed in the County of San Diego, where the mailing occurs; and my business address is the Law Offices of Brown, Martin, Haller & McClain, 1660 Union Street, San Diego, California 92101.

On August 10, 1998 I served the foregoing document described as:

Reply to Petition to Institute Public Under Proceeding Under 37 C.F.R. § 1.292

By U.S. Mail Service I caused each such envelope, with postage thereon fully prepaid, to be placed in the United States Mail at San Diego, California, by placing a copy thereof in a separate envelope for each addressee named hereafter, addressed to each such addressee respectively as follows:

John R. Benefiel, Esq.  
280 Daines Street, Suite 100B  
Birmingham, Michigan 48009-6244

I declare under the penalty of perjury that the above is true and correct and that I am employed in the office of a member of the Bar of this Court at whose direction the service was made. Executed on August 10, 1998, at San Diego, California.

Mary E. Gillette  
Mary E. Gillette